

REMARKS

Formal Matters

Claims 34-39 are pending in the application. Claims 1-21 were previously canceled and claims 22-33 and 40-51 are presently canceled without prejudice to later prosecution. Claims 34-37 are amended. Claim amendments are made merely to advance prosecution of the claims and/or to narrow the issues on appeal should an appeal become necessary. Claims 22-33 and 36-51 are rejected. Claims 34 and 35 are objected to.

Objection to the Claims

The Examiner states on page 5 of the Office Action that claims 34 and 35 are free of the prior art and are objected to because they are dependent from a rejected claim (dependent from claim 22). Claim 34 is amended to be independent and claims 35-37 are amended to be dependent from claim 34. Claims 38 and 39 (not amended) are also ultimately dependent from claim 34. Thus, claims 34-39 are free of the prior art and in condition for allowance, which action is respectfully requested.

Rejection under 35 U.S.C. § 103(a) (Rajkumar et al. in view of Orlandi et al., Cabilly et al., Boss et al., Robinson et al., Ward et al., Queen et al., and Huston et al., all of record)

Claims 22-33 and 36-51 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rajkumar et al. in view of Orlandi et al., Cabilly et al., Boss et al., Robinson et al., Ward et al., Queen et al., and Huston et al. (all references are of record). Applicants traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons below.

Rejection of claims 22-33 and 39-51 is rendered moot by their cancellation.

Claims 36-39 are amended to be dependent from claim 34 and are allowable, having overcome the objection to claim 34. Thus, the rejection of claims 36-39 is rendered moot.

Applicants have cancelled claims 22-33 and 40-51 without prejudice to later prosecution and without acquiescing to the rejection under Section 103(a) for reasons provided in the Response/Amendment filed May 4, 2004. Applicants respectfully submit that the Examiner has not met his burden of demonstrating a case of prima facie obviousness of Applicants' claims over the combination of cited references. The Examiner appears to suggest that properties of one antibody are inherent to all antibodies that bind the same antigen. Such is simply not the case. The Rajkumar et al. reference teaches that the SGP1 antibody is an antibody that either increases activity (as an agonist of anchorage-independent tumor cell growth) or has no affect on activity (as in anchorage-dependent tumor cell growth and tyrosine phosphorylation activity) in cells expressing ErbB2 and ErbB3. By contrast, Applicants claim a nucleic acid that encodes an antibody that reduces ErbB2-ErbB3 complex formation or reduces ErbB2 activation in a cell expressing ErbB2 and ErbB3. Thus, the properties of the prior art antibody are not inherent to the properties of the antibody encoded by the claimed nucleic acid.

Having narrowed the issues for appeal, should an appeal become necessary, and having overcome the rejection and objection, Applicants respectfully request entry of the claim amendments and allowance of the claims.

SUMMARY

Claims 34-39 are pending in the application. Claims 22-33 and 40-51 are canceled herein without prejudice to later prosecution.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for three-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize

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charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

GENENTECH, INC.

Date: February 4, 2005

By:


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